

R E M A R K S

Claims 1 and 8-19 are pending in this application. No new matter has been added by way of the present amendment. For instance, claims 1 and 17 have been amended into method for "inhibiting sebum production" claims in order to bring these claims in line with the other method claims, for instance, method claims 8, 13, 18 and 19. Additionally, the recitation of "preventing" has been removed from claims 8 and 13. Lastly, the recitation of "increased" has been removed from claims 10 and 11. New claims 18 and 19 are supported by claims 8 and 13. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow all currently pending claims.

Issues under 35 U.S.C. 112, second paragraph

The Examiner has rejected claims 8, 10, 12 and 13 under 35 U.S.C. 112, second paragraph for the reasons recited at page 2 of the outstanding Office Action. Applicants respectfully traverse these rejections.

First, the Examiner has rejected claims 8 and 13 asserting that the claims required administration to a subject presenting the disorder, however, it is allegedly not clear how a disorder is to be prevented in a subject already afflicted with the

disease. Applicants traverse and submit that claims 8 and 13 have been amended to clarify this subject matter. Additionally, although the subject matter relating to "preventing" various dermatological disorders has been removed from claims 8 and 13, Applicants note that new claims 18 and 19 relate to the deleted subject matter. In this regard, the Examiner is referred to Example 6 of the present specification (from page 6, line 21 to page 28, line 19), which shows that the compounds according to the present invention exhibit an excellent sebum production inhibitory effect. Therefore, Applicants submit that the compounds will inevitably prevent a disease caused by excessive sebum production and oily skin condition.

Second, the Examiner has rejected claims 10 and 12 for the recitation of "increased" dandruff or "increased" body odor. Applicants respectfully traverse this rejection and submit that the term "increased" has been removed from each of these claims.

Accordingly, Applicants respectfully submit the present claims define subject matter that fully satisfies the requirements of 35 U.S.C. 112, second paragraph. Reconsideration and withdrawal of all rejections is respectfully requested.

Issues under 35 U.S.C. 102(a)

The Examiner has rejected claims 1 and 17 under 35 U.S.C. 102(a) as being anticipated by JP 11-310588, JP 10-372864 (correctly JP 2000-191538) and JP 10-273895 (correctly JP 2000-103738). Applicants respectfully traverse each of these rejections.

None of the cited references suggest or disclose a method for inhibiting sebum production in a mammal in need thereof comprising administering the sebum production inhibitor as defined in claims 1 and 17. Accordingly, no anticipation exists. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. 102(b)

The Examiner has rejected claims 1, 8-15 and 17 under 35 U.S.C. § 102(b) as being anticipated by EP 295092, (hereinafter referred to as EP '092).

Concerning claims 1 and 17, Applicants respectfully submit that EP '092 fails to suggest or disclose administering the presently claimed compounds for the purpose of inhibiting sebum

production. Accordingly, no anticipation based upon EP '092 exists.

Concerning the other "method of use" claims (see claims 8-15), Applicants note that the Examiner asserts that since EP '092 discloses the administration of the composition for the enhancement of hair growth, all of the recited disorders would be inherently preventive. Applicants disagree with this rationale. In particular, when dealing with method of use claims, a new method of use, unless specifically recognized by the reference, cannot be inherently anticipated. Accordingly, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Issues Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1 and 8-17 under 35 U.S.C. § 103(a) as being obvious over EP '092.

Applicants traverse. The Examiner asserts that it would have been allegedly obvious to administer the disclosed compositions for the treatment of alopecia. However, the treatment of alopecia and the stimulation of hair growth are different disorders. Additionally, the fact that the reference discloses the application of the compositions to rejuvenate aged and wrinkled skin cannot properly be expanded to the treatment of body odor associated with aging. Thus, this rejection is improper and should be withdrawn.

The Examiner has also rejected claims 1, 8, 10, 16 and 17 under 35 U.S.C. § 103(a) as being obvious over EP '092 in view of Shiseido (JP 11-236391).

Applicants traverse. The Examiner admits that EP '092 does not disclose the treatment of dandruff, however, asserts that the Shiseido reference discloses the use of hyaluronic acid for the treatment of dandruff. Applicants respectfully submit that the Examiner's statement that "SHISEIDO teaches the use of HA for the treatment of dandruff" is incorrect. The invention disclosed in the Shiseido application requires as essential components acetylated hyaluronic acid and a specified blood circulation promoter. Shiseido discloses that only a combination of acetylated hyaluronic acid and a specified blood circulation promoter can exhibit superior anti-hair loss effects and have the ability to prevent dandruff and itching of the scalp. Acetylated hyaluronic acid alone does not exhibit such effects (Please see Examples; the composition of Comparative Example 1 uses Acetylated hyaluronic acid alone as an active ingredient). For the Examiner's reference, Applicants enclose an abridged translation of Shiseido's application.

In summary, there is exists no motivation based upon EP '092 and Shisheido to arrive at the presently claimed subject matter. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Obviousness-Type Double Patenting

The Examiner has rejected claims 1 and 17 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-8 and 19 of United States Patent No. 6,613,897.

Applicants respectfully traverse and submit that claims 1 and 17 relate to method for inhibiting sebum production in a mammal and the need thereof comprising administering effective amount of a compound as claimed in claims 1 and 17. This subject matter is not claimed in U.S. Patent 6,613,897. Additionally, there is no motivation in U.S. Patent 6,613,897, to pursue this claimed subject matter. Thus, this rejection is improper and should be withdrawn.

In view of the above, Applicants respectfully submit that the present claims define subject matter that is patentable over the cited art. Reconsideration and withdrawal of all outstanding rejections are respectfully requested.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie (Reg. No. 42,874) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #28,977
Gerald M. Murphy, Jr., #28,977

GMM/CAM:bmp
0230-0174P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Abridged translation of cited reference
JP 11-236619 (Shiseido)

(Rev. 02/12/2004)